



The applicant submits that Gerner does not anticipate this invention for the following reasons:

1. Gerner is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention;
2. Gerner does not disclose the purpose, means or mechanism that this invention discloses;
3. Gerner does not solve the problems this invention solves; and
4. Gerner does not disclose each and every element of this invention.

First of all, Gerner does not and cannot perform the function this invention as claimed. In Gerner, the main conveyor, i.e. the conveyor that receives the feedstock, is moving toward the shredder, and so is the secondary or second conveyor. In this invention, the second conveyor has a conveyor surface which moves away from the shredder feed aperture, which is directly opposite that in Gerner. Instead, Gerner requires that the primary feed conveyor be completely stopped and reversed in order to remove a clog.

This invention on the other hand does not require the primary feedstock conveyor be stopped and reversed, and the Gerner is not capable of providing this kind of continuous feedstock feeding operation. With the second conveyor in Gerner moving the feedstock toward instead of away from the feed aperture, it is not capable of preventing or reducing clogs therein.

There is no anticipation by a prior patent not known or recognized as being capable of performing the function of the patented device, but rather the

prior patent must itself do the teaching. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. v. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

The Gerner reference does not disclose the purpose, means and mechanism for accomplishing the instant invention. The means for preventing clogging in this invention is a second conveyor with a conveyor surface moving away from the feed aperture, which is much different than that in Gerner. This invention solves the clogging problem continuously during operation without requiring a conveyor, especially the primary feedstock conveyor, to be stopped and reversed, thereby halting the flow of the feedstock to the shredder.

There is no anticipation where a reference does not disclose the purpose, means and mechanism for accomplishing the instant invention but rather is restricted to a limited and different means. Sperry Products, Inc. V. Aluminum Company of America, 120 U.S.P.Q. 362.

The Gerner reference further does not solve the problem that this invention does, as explained above.

There is no anticipation if a prior patent does not solve the problem(s) which the subsequent patent successfully solves. Technical Development Corporation v. Servo Corporation of America, 125 U.S.P.Q. 133.

The Gerner reference does not disclose each and every element of the claimed invention, as required for a *prima facie* case of anticipation, and as stated more fully above. Gerner does not provide a "second conveyor having a conveyor surface moving away from the shredder feed aperture", but instead

requires the primary feedstock conveyor to be stopped and reversed. Furthermore, Gerner does not include a "second conveyor with a second conveyor inlet disposed to received excess feedstock from the first conveyor outlet".

There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Obviousness - Section 103(a) Rejection

The examiner has rejected the claims for obviousness based on Gerner in light of the admitted prior art. Applicant requests the Examiner reconsider the rejection for the reasons stated above relative to anticipation, and further because there is nothing in either reference which teaches or suggests this invention as claimed.

Gerner and the admitted prior art in fact teach away from this invention. There is nothing in Gerner which teaches or suggests using a second conveyor, a non-primary feedstock conveyor, with a conveying surface which moves away from the feed aperture to avoid clogging without the need to stop and/or reverse the movement of the primary feedstock conveyor.

Furthermore, there is nothing in the Gerner reference which suggests the desirability of the combination and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner of application from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO "failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching,



suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Conclusion

Applicant therefore submits Claims 1 - 6 are in a position to proceed to allowance.

Respectfully submitted,

Dated: 6/17/02

By: Mark W. Hendrickson
Mark W. Hendrickson
Reg. No. 32,356